

REMARKS

In the Office Action dated September 12, 2005, claims 1, 2, 4, 27, and 33 were rejected under 35 U.S.C. § 102 over U.S. Patent Application Publication No. 2002/0166127 (Hamano); claims 9, 10, 17-19, 28, and 30 were rejected under § 103 over Hamano in view of U.S. Patent No. 5,781,894 (Petrecca); claim 3 was rejected under § 103 over Hamano in view of U.S. Patent No. 6,067,570 (Kreynin); claim 29 was rejected under § 103 over Hamano in view of U.S. Patent No. 6,463,468 (Buch); and claims 11-16, 20, 21, and 34 were rejected under § 103 over Hamano in view of U.S. Patent Application Publication No. 2003/0171990 (Rao).

The rejection of independent claim 11 over Hamano in view of Rao is discussed first. It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 11 over the asserted combination of Hamano and Rao for at least the reason that no motivation or suggestion existed to combine the teachings of Hamano and Rao. *See* M.P.E.P. § 2143 (8<sup>th</sup> ed., Rev. 3), at 2100-135.

As conceded by the Office Action, Hamano fails to disclose a memory to store a frequency weight to determine frequency of displaying the commercial message, where the frequency weight has a value assigned according to the revenue generating capacity of the commercial message. 9/12/2005 Office Action at 8. Instead, the Office Action relied upon Rao as disclosing this feature, citing specifically to ¶ [0026], lines 1-19, of Rao. *Id.*

Hamano relates to displaying advertisements during a downtime of a display terminal, such as during a booting up process, when the display terminal is woken up, or as a screensaver. On the other hand, Rao is related to how a publisher can maximize revenue associated with displaying advertisements in specific ad positions of a web page. As depicted in Fig. 1A of Rao, a provider 110 may target potential customers by purchasing impressions (advertisements) in ad positions provided in a web page by the publisher 120. Rao, ¶ [0041]. The publisher 120 may sell campaigns and impression goals to one or more providers, such as provider 110. Rao, ¶ [0042]. The advertisements are provided by an ad server 130 (Fig. 1B) as users (members of advertising audience 140) access web pages at websites. Rao, ¶ [0038]. Fig. 2 of Rao shows an example web page (a travel web page) containing several banner ad positions 210-250. Rao, ¶ [0041]. Thus, what Rao contemplates is the presentation of advertisements in a web page as a

user is actively accessing a web page provided by the publisher 120 or ad server 130 in the system of Rao.

A person of ordinary skill in the art looking to the disparate teachings of Hamano and Rao would not have been motivated to combine their teachings. It is well established law that “[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (emphasis added). As the Federal Circuit has stated, “virtually all [inventions] are combinations of old elements.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). “Most, if not all, inventions are combinations and mostly of old elements.” *Id.*

Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’

*Id.*

As noted above, while Hamano is directed to display of advertisements during a specified downtime (booting up, waking up, or as a screensaver), Rao is directed to something completely different, namely presenting banner advertisements as a user is accessing some commercial web page, such as a travel-related web page. There existed no reason to combine the teachings of Rao with those of Hamano to achieve the claimed invention. Except for the disclosure of the present invention, no suggestion existed in Hamano and Rao to combine the reference teachings. Therefore, such a combination is based on impermissible hindsight. See *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”).

In view of the foregoing, it is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 11.

Claims 30 and 34 have been amended from dependent form to independent form. Claim 34 is allowable over Hamano and Rao for reasons similar to those of claim 11. Note that the scope of amended claim 34 has been broadened.

Claim 30 was rejected as being obvious over Hamano and Petrecca. With respect to claim 30, the Office Action incorrectly stated that Hamano discloses assigning a frequency weight to a commercial message based on the revenue generating capacity of the commercial message. In the rejection of claim 30, the Office Action cited ¶ [0036]. 9/12/2005 Office Action at 6. Paragraph [0036] of Hamano states that the advertisements help service providers by receiving advertising revenue from merchants placing the advertisements, and that from the merchant's point-of-view, their advertisements are reaching the correct audience and thus are effective. However, this passage does not teach or suggest the assigning of a frequency weight to a commercial message *based on a revenue generating capacity of the commercial message*. This feature also is not taught by Petrecca. Thus, the hypothetical combination of Hamano and Petrecca fails to teach or suggest all elements of claim 30. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 30.

Independent claim 1 was rejected as being anticipated by Hamano. Amended claim 1 recites displaying a selected commercial message on a display device during a user waiting time, wherein the user waiting time includes waiting time associated with the computer entering sleep mode. Displaying a commercial message when the computer is entering sleep mode is not disclosed by Hamano. Therefore, claim 1 is not anticipated by Hamano.

In view of the allowability of the independent claims, it is respectfully submitted that the rejections of dependent claims have been overcome.

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Allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 08-2025 (200304366-1).

Respectfully submitted,

Date: \_\_\_\_\_

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